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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057845
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MULTISORB TECHNOLOGIES, INC., Petitioner, v. CLARIANT INTERNATIONAL AG, Registrant.	Cancellation No.: 92057845 Application Serial No. 77823729 Registration No.: 3859182 Mark: OXY-GUARD

PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO STRIKE REGISTRANT'S AFFIRMATIVE DEFENSES

Petitioner Multisorb Technologies, Inc. ("Multisorb"), submits this reply brief in support of its Motion to Strike ("Motion") Clariant International AG's ("Clariant") Affirmative Defenses and in response to Clariant's Response to Multisorb's Motion, which was filed on December 31, 2013.

INTRODUCTION

Clariant's Response to Multisorb's Motion ("the Response") requested that the Motion be denied on the basis of untimeliness. Clariant failed to address the merits of the Motion, and instead requested that the Board grant it more time, tantamount to a surreply brief, to respond substantively if the Board entertains the

Motion despite its untimeliness. The Response also fails to address contradictory case law regarding the consideration of untimely motions, does not allege prejudice flowing from the untimely Motion, and is not supported by the rules. If the improper affirmative defenses are not stricken, then discovery in this matter will be unnecessarily broadened. As a result, the motion, though untimely, should be considered, Clariant should not be given additional time to respond to the motion, and Clariant's affirmative defenses should be stricken for the reasons set forth in Multisorb's Motion.

ARGUMENT

I. Clariant Ignores Contradictory Case Law In Its Position That The Untimely Motion Should Not Be Considered By the Board

As demonstrated in Multisorb's Motion, an untimely motion to strike may still be entertained by the board in appropriate circumstances. Clariant concedes as much in its Response, since it cites to an example of a case wherein the Board entertained not only one, but two untimely motions to strike. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) as cited in par. 2 of Clariant's Response. While Clariant also notes a TBMP provision that "motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case," this incomplete statement plucked from TBMP Section 506.02 concludes with the language

"[n]evertheless, the Board grants motions to strike in appropriate cases." The cases cited in TBMP Section 506.02 n. 7 list situations where motions to strike were deemed appropriate, and include examples of defenses that are very similar or identical to the defenses at issue here. *See e.g.* 506.02 n. 7 *citing Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292, 1295 n.16 (TTAB 1999) (estoppel may not be asserted as a defense against claims of mere descriptiveness); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (insufficient affirmative defenses stricken); *Harsco Corp. v. Electrical Sciences Inc*., 9 USPQ2d 1570, 1571-72 (TTAB 1988) (immaterial allegation stricken).

Clariant's proposed strict interpretation of TBMP Section 506 would have the Board believe that all untimely motions to strike should be rejected. Such an interpretation not only contradicts the language of the rule and analogous case law, it also runs afoul of the policy behind motions to strike, which is to "avoid the expenditure of time and money that must arise from litigating spurious issues." *Sidney-Vinstein v. A.H. Robins Co*., 697 F.2d 880, 885 (9th Cir. 1983). The board may, *sua sponte* strike the affirmative defenses on its own initiative at any time, and undoubtedly has the authority to do so in response to Multisorb's motion, even though it is untimely. *Veles Int'l Inc. v. Ringing Cedars Press LLC, Consolidated* Opp. Nos. 91182303 and 91182304 (T.T.A.B. June 2, 2008) (Board struck, *sua*

sponte, applicant's affirmative defenses of waiver, estoppel, and unclean hands). Here, Clariant's affirmative defenses are 'spurious', and to require Multisorb and this Board to spend the time and money required to deal with them would be nothing more than a pointless exercise. The pending Motion explains in detail why each of the affirmative defenses should be stricken. In sum, the rules, applicable case law, and overall policy all support this Board's review of the untimely Motion, as well as the Board's striking of Clariant's affirmative defenses.

II. Clariant Has Not Alleged Any Prejudice Flowing From The Delay In Filing The Motion To Strike; The Prejudice To Multisorb Is Evident.

In its Response, Clariant has not alleged that a review of the Motion would prejudice it in any way. If anything, the opposite is true, as any delay created as a result of the Board's review of the Motion will allow Clariant additional time to prepare its defenses.

On the other-hand, and as noted above, the prejudice of additional time and money, to both Multisorb and the Board that will result if the affirmative defenses are not stricken is real and impacting. Specifically, if the Board were to deny this Motion and accept pleadings that are irrelevant and so improperly plead that the pleadings do not provide Multisorb with fair notice as to the basis for the defenses, then Multisorb will bear the unreasonable burden and expense of blindly investigating each affirmative defense in discovery to determine Clariant's reasons

for asserting them. *See e.g. Canadian St. Regis Band of Mohawk Indians ex rel. Francis v. New York,* 278 F. Supp. 2d 313, 325 (S.D.N.Y. 2003) (stating that the prejudice requirement is satisfied if striking the defense would, for example, prevent a party from engaging in burdensome discovery, or otherwise expending time and resources litigating irrelevant issues that will not affect the case's outcome)*; United States v. Marisol, Inc.,* 725 F. Supp. 833, 836 (M.D. Pa. 1989).

Clariant's affirmative defenses simply do not warrant forcing Multisorb to bear this unnecessary burden and expense. Not striking the affirmative defenses would require Multisorb to propound additional, unnecessary discovery, which would only serve to confirm that Clariant has no factual basis for raising the defenses, resulting in the added cost and time to Multisorb to ultimately seek summary dismissal of them.

III. The Rules Do Not Allow Partial Responses to Motions To Strike And Surreply Briefs, And The Response Should Be Considered Uncontested Except For The Issue Of Timeliness.

Clariant should not be granted additional time to respond if the Board entertains the Motion because neither the rules nor judicial economy support piecemeal responses. To allow Clariant to submit another brief addressing the substance of the Motion would be to allow Clariant to submit a surreply brief, a direct violation of rule 502.02(b), which states in relevant part, "[n]o further papers (including surreply briefs) will be considered by the Board." *citing Pioneer*

Kabushiki Kaisha v. Hitachi High Technologies, 73 USPQ2d 1672, 1677 (TTAB 2005) (stating that because 37 CFR § 2.127(a) prohibits the filing of surreply briefs, the surreply in the matter was not considered). The result of the incomplete response is that the portions of the Motion not addressed in Clariant's answer should be considered conceded. *See e.g. Cent. Mfg. v. Third Milennium Tech., Inc.*, 61 U.S.P.Q.2d 1210 (TTAB 2001) (stating that since respondent had not filed a response to the movant's motion, the motion should be considered conceded under Trademark Rule 2.127(a)).

Because piecemeal responses and surreply briefs are not permitted by the rules, and because Clariant provides no explanation to the Board as to why it did not address the substance of the Motion in its Response, rule 502.02 dictates that the Motion should be considered conceded on all issues except for timeliness.

CONCLUSION

For all of the foregoing reasons, Multisorb requests that its Motion to strike be entertained by the Board, that Clariant not be given the opportunity to submit a further brief, and that all the issues addressed in the Motion be considered conceded, except for the issue of timeliness.

Dated: Spokane, Washington
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Respectfully Submitted,

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CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing document was sent via email to counsel for Registrant at the email addresses below on the 7th day of January, 2014:

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